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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/775,425

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Lee A. Chase

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01/09/2008

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EXAMINER

STORMER, RUSSELL D

ART UNIT

PAPER NUMBER

3617

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/775,425

Applicant(s)

CHASE ET AL.

Examiner

Russell D. Stormer

Art Unit

3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 29-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 12, 2007 has been entered.

***Response to Amendment***

Applicant's amendments to the claims and specification concerning the term "flangeless rim" and "flangeless wheel" are effective to overcome the objections to the specification and drawings set forth in the last office action (mailed July 31, 2007) in paragraphs 2, 3, and 5.

The term "truncated" finds support in the specification as originally filed February 1, 2001, and the term "minimum function flange height" appears in the provisional application 60/084378.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 29, 32, 33, 41, 53, 56, 57, 65, and 66 are rejected under 35 U.S.C. 102(b) as being anticipated by Beam.

The rim flange shown in figure 5 is considered to be truncated as the axial extension of the flange lip is limited. The diameter of the overlay is clearly less than that of the wheel rim so it would be less susceptible to damage from wheel handling equipment.

With respect to claims 33 and 57, an offset is shown at 44 or 46, both of which would help locate the overlay on the wheel.

With respect to claim 41, a balance weight is shown in figure 4.

Claims 29, 32, 33, 34, 53, 56, 57, 58, 65, and 66 are rejected under 35 U.S.C. 102(b) as being anticipated by Chase.

Chase (U.S. Patent No. 5597213; hereafter Chase '213) discloses a wheel and overlay assembly comprising an overlay adhesively attached to the wheel and having a flange whose outer diameter at the flange lip is clearly less than that of the rim. See figures 5, 6, and 7. This structure would inherently reduce the potential for damage caused by tire-changing equipment. As shown in figure 7, the rim has an outer lip 522 which is considered to be truncated inasmuch as it is axially shorter than some of the other flange lips shown in the patent, such as the lip 122 shown in figure 3.

The overlay may have an offset 120 as shown in figure 3.

With respect to claims 34 and 58, note that the overlay may be secured to the wheel by a foam adhesive and a silicon adhesive for sealing the assembly as described in column 9, lines 32-43.

Claims 29, 32, 33, 34, 53, 56, 57, 58, 65, and 66 are rejected under 35 U.S.C. 102(b) as being anticipated by Chase et al.

Chase et al (U.S. Patent No. 5597213; hereafter Chase et al '791) discloses a wheel and overlay assembly comprising an overlay adhesively attached to the wheel and having a flange 122 whose outer diameter at the flange lip 122a is clearly less than that of the rim. See figure 2. This structure would inherently reduce the potential for damage caused by tire-changing equipment. As shown in figure 4, the rim has an outer lip 320 which is considered to be truncated at the radially inwardly facing flat cylindrical surface.

The overlay may have an offset such as at 22, 122a, and 322a.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 30, 31, 35-40, 54, 55, and 59-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beam.

With respect to claims 30, 31, 54, and 55, the tolerances between the edge of the overlay and the outermost edge of the rim flange lip would have been obvious as design expedients because those of ordinary skill in the art could readily determine suitable dimensions for the overlay to produce a desired amount of coverage, and also could determine the tolerance needed or desired to properly cover the wheel rim.

With respect to claims 35-40 and 59-64, the materials and finishes claimed are all notoriously well-known in the art and to choose any of them would have been obvious to those of ordinary skill in the art to achieve a desired property or appearance. Official Notice is hereby given with respect to claims 35-40 and 59-64.

Claims 30, 31, 35-40, 54, 55, and 59-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chase '213.

With respect to claims 30, 31, 54, and 55, the tolerances between the edge of the overlay and the outermost edge of the rim flange lip would have been obvious as design expedients because those of ordinary skill in the art could readily determine suitable dimensions for the overlay to produce a desired amount of coverage, and also could determine the tolerance needed or desired to properly cover the wheel rim.

With respect to claims 35-40 and 59-64, the materials and finishes claimed are all notoriously well-known in the art and to choose any of them would have been obvious to those of ordinary skill in the art to achieve a desired property or appearance. Official Notice is hereby given with respect to claims 35-40 and 59-64. It is noted that Applicant has not challenged this taking of Official Notice from the previous office action in the Arguments filed October 12, 2007, and therefore the subject matter of claims 35-40 and 59-64 is taken to be admitted prior art. See MPEP 2144.03.

Claims 42-46 and 48-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumgartner et al in view of Eikhoff et al.

Baumgartner et al (U.S. Patent 6068350; hereafter Baumgartner et al) discloses an overlay for a flangeless (lipless rim flange) wheel rim comprising a cover adhesively attached to the wheel as shown in figure 3. Offsets, at 51 or 58, can be used to locate the overlay on the wheel. The flange is not described as a minimum function flange, but is considered to have a minimum function flange height inasmuch as the height of the flange is at least the minimum height necessary to retain the tire bead on the rim.

With respect to claims 48-51, the materials and finishes claimed are all notoriously well-known in the art and to choose any of them would have been obvious to those of ordinary skill in the art to achieve a desired property or appearance. Official Notice is hereby given with respect to claims 48-51. It is noted that Applicant has not challenged this taking of Official Notice from the previous office action in the Arguments filed October 12, 2007, and therefore the subject matter of claims 48-51 is taken to be admitted prior art. See MPEP 2144.03.

The outer edge of the overlay at 58 is not described as having a diameter smaller than that of the rim flange at 41.

Eikhoff et al teaches an overlay for a wheel comprising a cover which closely fits over the wheel and may extend beyond the outer diameter of the rim (figure 10) or may have a diameter smaller than that of the rim as shown in figure 11. From this teaching it would have been obvious to size the overlay of Baumgartner et al to have a diameter that was smaller than that of the rim in order to prevent the tire from contacting the overlay during use.

With respect to claim 52, it would have been obvious for the rim to have a standard dimension in order to receive a balancing weight to so that the wheel could be balanced using conventional weights.

Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baumgartner et al in view of Eikhoff et al as applied to claim 45 above, and further in view of Chase '213.



To use a foam adhesive and a bead of adhesive along the outer areas of the overlay of Baumgartner et al as modified by Eikhoff et al would have been obvious as taught by Chase '213 in order to retain the overlay with a lighter weight foam adhesive and also to seal the edges of the assembly to keep out water and other materials.

### ***Response to Arguments***

Applicant's arguments filed October 12, 2007 have been fully considered but they are not persuasive.

It is still felt that each of the references show overlays which have an outer peripheral flange whose diameter is smaller than the outer diameter of the rim flange. Tire changing equipment as broadly set forth in the claims would not contact the flange of the overlay due to this arrangement.

The terms "truncated" and "minimum function flange height" in the claims are noted, but without corresponding structure being positively claimed, the terms are given little patentable weight.

Each of the references discloses an overlay which would give the visual appearance that the overlay is actually the outboard face of the wheel. Note for instance lines 13-23 of column 7 of Chase '791, and the Summary of the Invention of Beam.


The affidavit submitted by Lee Alan Chase, and the affidavits submitted as Exhibits A and B have been fully considered, and are acceptable in defining the terms and phrases in question.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell D. Stormer whose telephone number is (571) 272-6687. The examiner can normally be reached on Monday through Friday, 9 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joe Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

1/4/08

  
RUSSELL D. STORMER  
PRIMARY EXAMINER 1/4/08